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EXAMINER

MITCHELL, KATHERINE W

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 20040413

Application Number: 10/029,818
Filing Date: December 31, 2001
Appellant(s): BRETT, JOYCE

Myron Amer
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed Feb 25, 2004.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(3) Status of Claims

This appeal involves claim 1.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Invention

The summary of invention contained in the brief is correct. However, the use of the trademark BAND AID® has been noted in this brief. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications and briefs, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

There is only 1 (one) claim. Grouping does not apply.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim 1 is rejected under 35 U.S.C. 112 and 103. This rejection is set forth in prior Office Action, Paper No. 20031224.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. First and second adhesive deposits were never shown or disclosed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Vesey USP 6455752 in view of Arginsky US D 340,988 and Amen-Ra, USP 6472039.

➤ Vesey shows a method of arranging for a jewelry display to be worn on a person at a location typically having cosmetics applied comprising an adhesive bandage with a central gauze pad and adhesive strips with overlapping release strips (Fig. 2), and a

Art Unit: 3677

jewelry display 14. A plastic as the bandage material is taught in column 3 lines 22-33, and column 5 lines 20-23 teach a clear plastic bandage is preferable. Vesey states the bandage can be a Johnson & Johnson BAND-AID™ bandage, which is suitable for use on skin covered by cosmetics and is at least substantially similar to the BAND AID™ used by appellant.

- However, Vesey does not specifically teach venting openings. Vesey is also silent on first and second adhesive deposits and that rhinestone jewelry is adhesively secured.
- While Band-Aid™ strips are inevitably vented, and the adhesive used to adhere the decorations to the Band-Aid™ would inevitably contact and grip the vents of the Band-Aid™ of Vesey, Arginsky specifically teaches an adhesive bandage with decorative value including the use of venting openings in an adhesive bandage, and any adhesive decoration of Vesey would inevitably grip at the vents.
- As discussed above, the newly-added limitations of first and second adhesive deposits in specific locations is considered new matter, as it is not found in the application as originally filed. However, now that appellant has explained that the first adhesive deposit is the adhesive deposit applied by the Band-Aid™ manufacturer, the Vesey Band-Aid™ inevitably has the same first adhesive on its laterally extending strips, as it is an adhesive bandage – see column 2 lines 1-3 and column 3, lines 34-44 of Vesey. The second adhesive is on the “adhesive stickers and adhesive tattoos” of Vesey column 2 lines 4-10. The adhesive on the backing of

the stickers and tattoos is inevitably viscous, using the following definition absent any further definition by appellant:

vis-cous (vîs¹kes) *adjective*

1. Having relatively high resistance to flow.¹

and the second adhesive will inevitably flow into the vent holes which are a known property of Band-Aid™ bandages.

- Amen-Ra teaches that body appliquéés for attachment to the body, eyelid, etc of a person can include decals, rhinestones, and other decorative elements in column 1 lines 16-50. Amen-Ra further teaches in column 2 lines 1-9 that the body appliquéés are attached to a polymeric generally transparent thin film which supports the jewelry, which may be stones, plastic, or anything aesthetically pleasing, and that the jewelry is “attached and bonded to the top surface of the thin film or substrate so as to form the appliqué having an adhesive backing which appliqué may be attached to a body part, eye lids,...” Attached and bonded is further disclosed by Amen Ra in column 4 line 64–column 5 line 2 to include adhesive securement “which will not dissolve the polymeric film substrate and which will act to secure the rhinestones or other materials to the upper surface of the substrate in a secure manner”, thus the adhesive is cured.
- Therefore, it would have been obvious to a person having ordinary skill in the art at the time of appellant's invention to modify the adhesive bandage to have venting

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Art Unit: 3677

openings in view of Arginsky in order to provide a means of allowing the passage of air to the wound to help heal the wound. Rhinestones are an obvious equivalent decorative element for body appliqués, as taught by Amen-Ra in column 4 lines 4-9. The claimed method is an obvious method of using/forming Vesey's device, and in regards to the placement of such bandage on a person at a location on which a cosmetic is typically applied, Amen Ra teaches that the appliqué can be used on body parts, the eyelids or nails, which commonly have cosmetics applied to them, and the examiner takes Official Notice that it is well known for adhesive bandages to be applied to the face; such is commonly done by a person after an injury resulting from shaving, or when such person has cut or otherwise injured the skin on the face.

- Appellant has not argued examiner's Official Notice that BAND AIDS® are known to be used on and suitable for use on a face, which commonly is covered by cosmetics, and thus the point is considered accepted by appellant.

(11) Response to Argument

Appellant argues that the rejection under 35 USC 112, first paragraph should be overruled.

Examiner originally believed appellant was claiming an undisclosed additional application of adhesive. However, appellant has clarified that the first adhesive deposit is that deposit applied by the "manufacture (sic) of the article of manufacture (i.e., Johnson & Johnson) of the bandage" and the second adhesive is deposited "by the appellant in preparation of arranging for a jewelry display using the bandage". Appellant has claimed a method for arranging for a jewelry display on an existing adhesive

bandage, and thus cannot include a step of "applying a first adhesive deposit on said laterally extending strips" of the existing adhesive bandage, as this is an existing property of the adhesive bandage and not a step of the claimed method.

Regarding the adhesive on the existing Band-Aid™, Appellant's original disclosure contained only:

For its medical or first aid end use, the central gauze pad 18 has release strips 28 and 30 in overlapping relation, as at 32, beneath the gauze pad 18, each of which is connected to extend from the gauze pad 18 in contact against the adhesive surfaces of the adhesive strips 20 and 22 to thusly neutralize or obviate an adhesive function of the adhesive strips 20, 22 until the Band-Aid 16 is put to use. While the release strips 28 and 30 are in place, the Band-Aid 16 is readily handled without difficulty, and the handling contemplates the deposit of a viscous, not yet cured, appropriate adhesive 34, such as an adhesive commercially available ..."

Appellant did not disclose that the adhesive was applied on the strips, nor could appellant have any control of that step, as that is done by the adhesive bandage manufacturer. The adhesive surface could be applied as the laterally extending strips are formed, or the laterally extending strips could have a basic adhesive property and not need adhesive to be applied.

Appellant argues that the rejection under 35 U.S.C. 103(a) should be overruled.

Appellant argues that the vent openings contributing to the gripping engagement of the adhesive deposit are not taught in the prior art as applied. As discussed in the rejection, Vesey uses a Band-Aid™, which inevitably has vent holes, but examiner cited Arginsky to further document that vent holes in an adhesive bandage are old and well known. The decorative elements, adhesive stickers or adhesive tattoo, of Vesey and

Art Unit: 3677



Amen-Ra include a viscous adhesive (Vesey column 4 lines 62-67, Amen-Ra column 4 lines 27-33). When using such adhesive deposits used in Vesey and Amen-Ra, on an existing Band-Aid™ with its intrinsic vent holes, the structure of the vent holes themselves would allow the flow of adhesive into the vent holes and increase adhesion and gripping engagement as a matter of course. Appellant has not argued the combination of Vesey in view of Arginsky and Amen-Ra, only that the claim limitations are not taught by the combination, and as discussed above, all the limitations are obvious over the combined teachings.

Appellant argues *In re Hiniker Co.*, which is concerning the anticipation of all limitations of a claim. However, the claim was rejected under 35 U.S.C. 103(a) as being obvious, not anticipated, and thus *In re Hiniker C.* is not relevant.


For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

kwm
April 19, 2004

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